

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jerding, *et al.*

Confirmation No.: 1598

Group Art Unit: 2623

Serial No.: 09/590,904

Examiner: Shang, Annan Q.

Filed: June 9, 2000

Docket No. A-6585 (191930-1180)

For: **PROGRAM INFORMATION SEARCHING SYSTEM FOR INTERACTIVE PROGRAM
GUIDE**

EVIDENCE UNDER 37 CFR 41.37

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks and evidence for consideration and entry before submission of an appeal brief.

REMARKS

Claims 2, 3, 5-30, 32-37 and 39-64 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Rothmuller* ("*Rothmuller*," U.S. Pat. No. 5,635,989) in view of *Legall et al.* ("*Legall*," U.S. Pat. No. 6,005,565). Claims 9-14 and 39-41 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Rothmuller* in view of *Legall*, and further in view of *Boyer et al.* ("*Boyer*," U.S. Pat. No. 6,268,849). Claims 2, 3, 5-30, 32-37, and 39-64 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The final Office Action alleged the following with regard to the 112(1) rejection (page 2, section 1):

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 63 and 64, it is unclear as to where support is found for the claimed "...browse-by icon..." recited in claims 63 and 64. There is no disclosure for the claimed "browse-by icon." Furthermore the specification and figures as originally presented do not illustrates[sic] the claimed "browse-by icon."

In the response to final dated November 13, 2007, Applicants provided an Exhibit A, corresponding to a marked-up version of Figure 4 of the original disclosure, with the "icon" encircled and labeled to assist the Examiner, and explained on page 14 of the response to final that exact terminology between specification and claims is not required, that the MPEP 2163 recognizes implicit and inherent disclosure of the claim limitation, and that even assuming *arguendo* there is no explicit disclosure shown and described in association with Exhibit A, the disclosure of the limitation "browse-by-icon" is at least implicit. Further, the response to final dated November 13, 2007 made the following note (page 14):

Additionally, based on Figure 4 and the well-established use of the term "icon" in display and graphics user interface technology, one having ordinary skill in the art would reasonably conclude possession of the claimed subject matter. In that the rejection is believed to have been overcome, Applicants respectfully request that the rejection of these claims under 35 U.S.C. §

112, first paragraph, where not rendered moot by cancellation of claims, be withdrawn.

The Advisory Action dated January 4, 2008 expressed that the Exhibit was considered, but disagreed with Applicants arguments, asserting that the "Exhibit A does not illustrate the claimed limitation 'BROWSE BY ICON'" and further asserting that there is "no disclosure for the claimed limitation 'browse-by-icon'. Hence the 103(a) rejection is proper."

The Panel Decision dated June 17 and based on the Pre-Appeal Brief Request for Review filed by Applicants on January 23, 2008 noted that there remains at least one issue for appeal.

Prior to filing an appeal brief, Applicants respectfully request consideration and entry of the attached Exhibit 1 under 37 CFR 41.37 and MPEP 1206. Exhibit 1 is a page containing an exemplary definition of the word "icon" from "Random House Webster's Unabridged Dictionary, Second Edition," dated August 1998. Such an exemplary definition provides in relevant part as follows:

1. a picture, image, or other representation...4. *Computers*. A picture or symbol that appears on a monitor and is used to represent a command, as a file drawer to represent filing.

Applicants respectfully submit that, consistent with the exemplary definition as attached, the symbol "A" in Applicants' Figure 4 (Exhibit A from the final Office Action response) appears on the screen of a display device and is used in conjunction with the text adjacent the symbol (i.e., "Browse By") to represent the ability to use the "A" button or key on a remote control device to command browse-by functionality in the IPG in the manner described in Applicants' specification and as claimed (e.g., page 10, lines 8-16 and page 12, lines 16-22).

Applicants respectfully submit that entry of Exhibit 1 is in compliance to MPEP 2106, which provides as follows:

Affidavits or other evidence (e.g., declarations or exhibits) submitted after the date of filing a notice of appeal, but prior to the date of filing a brief pursuant to 37 CFR 41.37, may be admitted if the examiner determines that:

(A) the affidavits or other evidence overcomes all rejections under appeal; and

(B) a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

To support entry of Exhibit 1, Applicants respectfully note the following supporting facts:

- (1) as of the filing date of the present response, there has been a filing of a Notice of Appeal but an appeal brief has not been filed; and
- (2) the evidence overcomes all rejections under appeal.

With regard to requirement (1) and the 112(1) rejection, it is evident that the exemplary definition of an icon as attached as Exhibit 1 was present by the filing date of the present application, and hence available to one having ordinary skill in the art. Further, in combination with the well-understood meaning of the term "icon," it is clear that Applicants were in possession of an embodiment of an invention that includes a browse-by icon." In addition, it is noted that there is an absence of any articulation in the final or Advisory Action of "why" a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed (as required under MPEP 2163.04), and hence a failure to support or maintain a *prima facie* case.

With regard to the 103 rejection, it is noted that the "browse-by" icon was completely ignored in the final Office Action and Advisory Action, and hence omits a necessary element needed to support of a *prima facie* case of obviousness.

For at least the reasons set forth above, Applicants respectfully submit that the evidence overcomes all rejections under appeal.

With regard to the second requirement under MPEP 2106 set forth above, Applicants respectfully submit that, despite Applicants' assertion in the prior responses of the well-established or universal acceptance of what an icon is and conveys, the evidence is necessary to convince the Examiner that it is unreasonable to take the position that one having ordinary skill in the art would not recognize that the combination of the "A" button in view of the adjacent text as a browse-by icon in view of what was known at the time of filing. Further, Applicants respectfully submit that in view of the well-established or universal recognition of anyone who has ever interacted with a computer (and it is noted that the standard for rejecting the claim under 112(1) is not so onerous, but instead, pertains to one having ordinary skill in the art), it was not believed necessary to have to support such assertions of well-established usage with an Exhibit. Instead, Applicants believed the inclusion of Figure 4 in Exhibit A in the response to final and the accompanying explanation would be sufficient to convince the Examiner that one having ordinary skill in the art would understand that the "A" symbol accompanied by the adjacent text pertains to the claimed browse-by icon." Accordingly, it is respectfully believed that the second requirement of MPEP 2106 has been met.

CONCLUSION

Favorable reconsideration and entry of the evidence and/or allowance, or the re-opening of prosecution on the merits, of the present application and claims 2, 3, 5-30, 32-37, 39-54, and 59-64 are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

By: _____/dr/_____

David Rodack, Reg. No. 47,034

600 Galleria Parkway
Suite 1500
Atlanta, Georgia 30339-5948
Tel: (770) 933-9500
Fax: (770) 951-0933

[illegible][illegible]

100